



Dkt. 41426-F-PCT-A-US/JPW/MAF/AJD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
For: PROSTATE-SPECIFIC MEMBRANE ANTIGEN AND USES
THEREOF

1185 Avenue of the Americas
New York, New York 10036
March 26, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

This Supplemental Information Disclosure Statement is submitted under 37 C.F.R. §1.97(b)(3) to supplement the Information Disclosure Statements filed on January 2, 2004 in connection with the above-identified application.

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants direct the Examiner's attention to the following references which are listed on the attached PTO-1449 form (**Exhibit A**), and attached hereto as **Exhibits 1-58**:

1. U.S. Patent No. 4,554,101, issued November 19, 1985 to Thomas P. Hopp;
2. U.S. Patent No. 5,162,504, issued November 10, 1992 to Julius S. Horoszewicz;
3. U.S. Patent No. 5,538,866, issued July 23, 1996 to Israeli et al.;
4. PCT International Application No. PCT/US93/10624, filed November 5, 1993, International Publication No. WO 94/09820, published May 11, 1994;
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 46. U.S. Patent No. 6,107,090, issued to Neil H. Bander on August 22, 2000;
 47. U.S. Patent No. 6,136,311, issued October 24, 2000 to Neil H. Bander;
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 50. PCT International Application No. PCT/US99/05864, filed March 18, 1999, International Publication No. WO 99/47554, published September 23, 1999;
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Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 8

65. U.S. Patent No. 5,672,592, issued September 30, 1997 to Paul F. Jackson and Barbara S. Slusher (**Exhibit 1**);
66. U.S. Patent No. 5,795,877, issued August 18, 1998 to Paul F. Jackson et al. (**Exhibit 2**);
67. U.S. Patent No. 5,804,602, issued September 8, 1998 to Barbara S. Slusher et al. (**Exhibit 3**);
68. U.S. Patent No. 5,863,536, issued January 26, 1999 to Paul F. Jackson et al. (**Exhibit 4**);
69. U.S. Patent No. 5,880,112, issued March 9, 1999 to Paul F. Jackson et al. (**Exhibit 5**);
70. U.S. Patent No. 5,902,817, issued May 11, 1999 to Paul F. Jackson et al. (**Exhibit 6**);
71. U.S. Patent No. 5,962,521, issued October 5, 1999 to Paul F. Jackson et al. (**Exhibit 7**);
72. U.S. Patent No. 5,968,915, issued October 19, 1999 to Paul F. Jackson et al. (**Exhibit 8**);
73. U.S. Patent No. 5,981,209, issued November 9, 1999 to Barbara S. Slusher et al. (**Exhibit 9**);
74. U.S. Patent No. 6,011,021, issued January 4, 2000 to Barbara S. Slusher et al. (**Exhibit 10**);
75. U.S. Patent No. 6,017,903, issued January 25, 2000 to Barbara S. Slusher et al. (**Exhibit 11**);
76. U.S. Patent No. 6,025,344, issued February 15, 2000 to Paul F. Jackson et al. (**Exhibit 12**);
77. U.S. Patent No. 6,025,345, issued February 15, 2000 to Paul F. Jackson et al. (**Exhibit 13**);
78. U.S. Patent No. 6,046,180, issued April 4, 2000 to Paul F. Jackson et al. (**Exhibit 14**);
79. U.S. Patent No. 6,054,444, issued April 25, 2000 to Paul F. Jackson et al. (**Exhibit 15**);
80. U.S. Patent No. 6,121,252, issued September 19, 2000 to Paul F. Jackson et al. (**Exhibit 16**);
81. U.S. Patent No. 6,271,245, issued August 7, 2001 to Paul F.

- Jackson et al. (**Exhibit 17**);
82. U.S. Patent No. 6,288,046, issued September 11, 2001 to Paul F. Jackson et al. (**Exhibit 18**);
 83. U.S. Patent No. 6,348,464, issued February 19, 2002 to Paul F. Jackson et al. (**Exhibit 19**);
 84. U.S. Patent No. 6,372,726, issued April 16, 2002 to Barbara S. Slusher et al. (**Exhibit 20**);
 85. U.S. Patent No. 6,384,022, issued May 7, 2002 to Paul F. Jackson and Barbara S. Slusher (**Exhibit 21**);
 86. U.S. Patent No. 6,395,718, issued May 28, 2002 to Barbara S. Slusher and Rena Lapidus (**Exhibit 22**);
 87. U.S. Patent No. 6,413,948, issued July 2, 2002 to Barbara S. Slusher et al. (**Exhibit 23**);
 88. U.S. Patent No. 6,452,044, issued September 17, 2002 to Paul F. Jackson et al. (**Exhibit 24**);
 89. U.S. Patent No. 6,458,775, issued October 1, 2002 to Paul F. Jackson et al. (**Exhibit 25**);
 90. U.S. Patent No. 6,479,471, issued November 12, 2002 to Paul F. Jackson et al. (**Exhibit 26**);
 91. U.S. Patent No. 6,586,623, issued July 1, 2003 to Takashi Tsukamoto et al. (**Exhibit 27**);
 92. Barbara S. Slusher and Krystyna Wozniak, U.S. Serial No. 09/866,729, filed May 30, 2001, U.S. Publication No. 20020013295, published January 31, 2002 (**Exhibit 28**);
 93. Paul F. Jackson et al., U.S. Serial No. 09/866,758, filed May 30, 2001, U.S. Publication No. 20020019430, published February 14, 2002 (**Exhibit 29**);
 94. Paul F. Jackson et al., U.S. Serial No. 09/880,861, filed June 15, 2001, U.S. Publication No. 20010044459, published November 22, 2001 (**Exhibit 30**);
 95. Takashi Tsukamoto et al., U.S. Serial No. 10/046,917, filed January 17, 2002, U.S. Publication No. 20030105088, published June 5, 2003 (**Exhibit 31**);

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 10

96. Barbara S. Slusher et al., U.S. Serial No. 10/056,079, filed January 28, 2002, U.S. Publication No. 20020151503, published October 17, 2002 (**Exhibit 32**);
97. Barbara S. Slusher et al., U.S. Serial No. 10/119,828, filed April 11, 2002, U.S. Publication No. 20030064912, published April 13, 2003 (**Exhibit 33**);
98. Paul F. Jackson et al., U.S. Serial No. 10/164,553, filed June 10, 2002, U.S. Publication No. 20030083374, published May 1, 2003 (**Exhibit 34**);
99. Barbara S. Slusher et al., U.S. Serial No. 10/209,011, filed August 1, 2002, U.S. Publication No. 20030017965, published January 23, 2003 (**Exhibit 35**);
100. Takashi Tsukamoto et al., U.S. Serial No. 10/431,462, filed May 8, 2003, U.S. Publication No. 20030216468, published November 20, 2003 (**Exhibit 36**);
101. U.S. Patent No. 5,773,292, issued June 30, 1998 to Neil H. Bander (**Exhibit 37**);
102. U.S. Patent No. 6,649,163, issued November 18, 2003 to Neil H. Bander (**Exhibit 38**);
103. Neil H. Bander, U.S. Serial No. 09/929,543, filed August 13, 2001, U.S. Publication No. 20020015704, published February 7, 2002 (**Exhibit 39**);
104. Neil H. Bander, U.S. Serial No. 09/929,546, filed August 13, 2001, U.S. Publication No. 20030031673, published February 13, 2003 (**Exhibit 40**);
105. David M. Nanus et al., U.S. Serial No. 10/160,994, filed May 30, 2002, U.S. Publication No. 20030007974, published January 9, 2003 (**Exhibit 41**);
106. Neil H. Bander, U.S. Serial No. 09/357,704, filed July 20, 1999;
107. Neil H. Bander, U.S. Serial No. 09/357,707, filed July 20, 1999;
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Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 11

109. Neil H. Bander, U.S. Serial No. 09/357,709, filed July 20, 1999;
110. Neil H. Bander, U.S. Serial No. 09/357,710, filed July 20, 1999;
111. Gerald P. Murphy et al., U.S. Serial No. 09/561,462, filed April 28, 2000;
112. Gerald P. Murphy et al., U.S. Serial No. 09/561,502, filed April 28, 2000;
113. Gerald P. Murphy et al., U.S. Serial No. 09/724,630, filed November 28, 2000;
114. Gerald P. Murphy et al., U.S. Serial No. 10/428,360, filed May 1, 2003, U.S. Publication No. 20040024188, published February 5, 2004 (**Exhibit 42**);
115. PCT International Application No. PCT/US02/17298, filed May 30, 2002, International Publication No. WO 02/096460 A1, published December 5, 2002 (**Exhibit 43**);
116. PCT International Application No. PCT/US02/17068, filed May 30, 2002, International Publication No. WO 02/098897 A2, published December 12, 2002 (**Exhibit 44**);
117. U.S. Patent No. 5,935,818, issued August 10, 1999 to Ron S. Israeli et al. (**Exhibit 45**);
118. U.S. Patent No. 6,569,432 B1, issued May 27, 2003 to Ron S. Israeli et al. (**Exhibit 46**);
119. Pending claims in Ron S. Israeli et al., U.S. Serial No. 08/403,803, filed March 17, 1995 (**Exhibit 47**);
120. Pending claims in Ron S. Israeli et al., U.S. Serial No. 08/466,381, filed June 6, 1995 (**Exhibit 48**);
121. Pending claims in Ron S. Israeli et al., U.S. Serial No. 08/470,735, filed June 6, 1995 (**Exhibit 49**);
122. Pending claims in Ron S. Israeli et al., U.S. Serial No. 09/990,595, filed November 21, 2001 (**Exhibit 50**);
123. Pending claims in Ron S. Israeli et al., U.S. Serial No. 09/724,026, filed November 28, 2000 (**Exhibit 51**);
124. Pending claims in Ron S. Israeli et al., U.S. Serial No.

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 12

- 08/481,916, filed June 7, 1995 (**Exhibit 52**);
125. Pending claims in Ron S. Israeli et al., U.S. Serial No. 10/012,169, filed October 24, 2001 (**Exhibit 53**);
126. Pending claims in Ron S. Israeli et al., U.S. Serial No. 10/443,694, filed May 21, 2003, U.S. Publication No. 20040001846, published January 1, 2004 (**Exhibit 54**);
127. Ron S. Israeli et al., U.S. Serial No. 10/614,625, filed July 2, 2003 (**Exhibit 55**);
128. Preliminary Amendment filed July 2, 2003 in connection with U.S. Serial No. 10/614,625 (i.e., reference 127) (**Exhibit 56**);
129. Pending claims in Ron S. Israeli et al., U.S. Serial No. 08/894,583, filed February 23, 1998 (**Exhibit 57**); and
130. PCT International Application No. PCT/US96/02424, filed February 23, 1996, International Publication No. WO 96/26272, published August 29, 1996 (**Exhibit 58**).

The Examiner is respectfully requested to make these references of record in the present application by initialing and dating the PTO 1449 form provided as **Exhibit A**, and returning a copy of the executed form to applicants' representatives with the next Communication concerning this application.

The subject application claims the priority of United States Application Serial No. 08/894,583, filed February 23, 1998, which is a national stage application under 35 U.S.C. 371 of PCT/US96/02424, filed February 23, 1996, which is a continuation-in-part of and claims priority of U.S. Serial Nos. 08/466,381 and 08/470,735, both filed June 6, 1995. Applicants note that the above listed references 1-42 were submitted to the Patent Office in an Information Disclosure Statement filed on July 11, 1997 in connection with U.S. Serial No. 08/466,381. The above listed references 43-50 were submitted to the Patent Office in Supplemental Information Disclosure Statements filed on March 20,

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 13

2000 and January 19, 2001, in connection with U.S. Serial No. 08/466,381. The above listed references 51-61 were submitted to the Patent Office in a Supplemental Information Disclosure Statement filed on June 27, 2001, in connection with U.S. Serial No. 08/470,735. The above listed references 62-64 were cited by the Patent Office in an Office Action issued on May 12, 1998 in connection with U.S. Serial No. 08/466,381. Accordingly, pursuant to 37 C.F.R. §1.98(d), copies of these references are not provided herein since they were previously cited by, or submitted to, the Patent Office in an application relied upon for an earlier filing date under 35 U.S.C. §120.

References 106-110 are applications claiming priority with U.S. Patent No. 6,107,090 to Bander (filed April 9, 1997 under U.S. Serial No. 08/836,682 and issued August 22, 2000). The Bander '090 patent is cited as reference 46 in the present Supplemental Information Disclosure Statement. Copies of references 106-110 are not provided as they are unpublished and unavailable to applicants. However, they are understood to be available to the Examiner for his review and consideration.

References 111-113 are applications claiming priority with U.S. Patent No. 6,150,508 to Murphy et al. (filed March 18, 1998 under Serial No. 09/044,668 and issued November 21, 2000). The Murphy et al. '508 patent is cited as reference 48 in the present Supplemental Information Disclosure Statement. Copies of references 111-113 are not provided as they are unpublished and unavailable to applicants. However, they are understood to be available to the Examiner for his review and consideration.

Applicants note that the above-cited references, 119-125, 127, and 129, are patent applications that are related to the present application and which have neither been issued as patents nor published. Reference 119 is a national stage counterpart of, and

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 14

references 120-123 are continuations of, PCT International Application No. PCT/US93/10624 (reference 4, above), published under International Publication No. WO 94/09820. A copy of International Publication No. WO 94/09820 was submitted to the Patent Office in an Information Disclosure Statement filed on July 11, 1997 in connection with U.S. Serial No. 08/466,381, upon which the subject application relies for an earlier filing date under 35 U.S.C. §120. Thus, as noted above, a copy of reference 4 is not provided herein pursuant to 37 C.F.R. §1.98(d). Further, pursuant to 37 C.F.R. §1.98(c), copies of references 119-123 are also not provided as they are cumulative. However, pursuant to 37 C.F.R. §1.98(a)(2), copies of the claims pending in references 119-123 are provided as **Exhibits 47-51**, respectively.

Reference 124 is a continuation of U.S. Serial No. 08/325,553. A copy of U.S. Serial No. 08/325,553, now U.S. Patent No. 5,538,866 (reference 3, above), was submitted to the Patent Office in an Information Disclosure Statement filed on July 11, 1997 in connection with U.S. Serial No. 08/466,381, upon which the subject application relies for an earlier filing date under 35 U.S.C. §120. Thus, a copy of reference 3 is not provided herein pursuant to 37 C.F.R. §1.98(d). Further, pursuant to 37 C.F.R. §1.98(c), a copy of reference 124 is also not provided as it is cumulative. However, pursuant to 37 C.F.R. §1.98(a)(2), a copy of the claims pending in reference 114 is provided as **Exhibit 52**.

References 125 and 126 are continuations of U.S. Serial No. 08/705,477, now U.S. Patent No. 6,569,432, a copy of which is enclosed as **Exhibit 46**. Pursuant to 37 C.F.R. §1.98(c), copies of references 125 and 126 are not provided as they are cumulative. However, pursuant to 37 C.F.R. §1.98(a)(2), copies of the claims pending in references 125 and 126 are provided as **Exhibits 53 and 54**, respectively.

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 15

Reference 127 (U.S. Serial No. 10/614,625) is a continuation-in-part of U.S. Serial No. 10/433,694, which is a continuation of U.S. Serial No. 08/705,477, now U.S. Patent No. 6,569,432, a copy of which is enclosed as **Exhibit 46**. Applicants attach hereto as **Exhibit 55** a copy of the specification and claims (corresponding to U.S. Serial No. 08/705,477) filed for U.S. Serial No. 10/614,625, together with a July 2, 2003 Preliminary Amendment (copy attached as **Exhibit 56**) which amended the specification and claims of U.S. Serial No. 10/614,625. The amended claims recited in this Preliminary Amendment are currently pending.

Reference 129 is a national stage counterpart of PCT International Application No. PCT/US96/02424, published under International Publication No. WO 96/26272, a copy of which is enclosed as **Exhibit 58**. Pursuant to 37 C.F.R. §1.98(c), a copy of reference 129 is not provided herein as it is cumulative. However, pursuant to 37 C.F.R. §1.98(a)(2), a copy of the claims pending in reference 129 is provided as **Exhibit 57**.

Further to the above, applicants direct the Examiner's attention to the article by Su et al. entitled "Alternatively Spliced Variants of Prostate-specific Membrane Antigen RNA: Ratio of Expression as a Potential Measurement of Progression" (Cancer Research 55: 1441-1443, 1995; reference 60, above), dealing with a splice variant of prostate specific membrane antigen. The first named author of the subject paper, Dr. Sai L. Su, has alleged that he was a co-inventor of claims directed to a splice variant of prostate specific membrane antigen contained in U.S. Patent No. 5,935,818 to Israeli et al. which issued August 10, 1999 and which is assigned to the Assignee of the present case. The subject matter of the claims of U.S. Patent No. 5,935,818 is not, however, the subject matter claimed in the present application. Applicants' representatives are investigating the

Applicants: Ron S. Israeli et al.
U.S. Serial No.: 10/751,346
Filed: January 2, 2004
Page 16

claim raised by Dr. Su.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone either of them at the number provided below.

Pursuant to 37 C.F.R. §1.97(b)(3), no fee is deemed necessary in connection with the filing of this Supplemental Information Disclosure Statement. However, if any fee is required authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Mark A. Farley

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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VA 22313-1450

Mark A. Farley 3-26-04
John P. White Date
Reg. No. 28,678
Mark A. Farley
Reg. No. 33,170

John P. White
Registration No. 28,678
Mark A. Farley
Registration No. 33,170
Attorneys for Applicant(s)
Cooper & Dunham, LLP
1185 Avenue of the
Americas
New York, New York 10036
(212) 278-0400



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					Filing Date January 2, 2004		Art Unit											
U.S. PATENT DOCUMENTS																		
Examiner Initials	Exh No	Document Number							Date	Name	Class	Subclass	Filing Date If Appropriate					
		0	9	3	5	7	7	0	9		Bander			07/20/99				
		0	9	3	5	7	7	1	0		Bander			07/20/99				
		0	9	5	6	1	4	6	2		Murphy et al			04/28/00				
		0	9	5	6	1	5	0	2		Murphy et al			04/28/00				
		0	9	7	2	4	6	3	0		Murphy et al			11/28/00				
	42	2	0	0	4	0	0	2	4	1	8	8	02/05/04	Murphy et al.			05/01/03	
	45	5	9	3	5	8	1	8		08/10/99	Israeli et al.							
	46	6	5	6	9	4	3	2		05/27/03	Israeli et al.							
	47	0	8	4	0	3	8	0	3		Israeli et al.					03/17/95		
	48	0	8	4	6	6	3	8	1		Israeli et al.					06/06/95		
	49	0	8	4	7	0	7	3	5		Israeli et al.					06/06/95		
	50	0	9	9	9	0	5	9	5		Israeli et al.					11/21/01		
	51	0	9	7	2	4	0	2	6		Israeli et al.					11/28/00		
	52	0	8	4	8	1	9	1	6		Israeli et al.					06/07/95		
	53	1	0	0	1	2	1	6	9		Israeli et al.					10/24/01		
	54	2	0	0	4	0	0	0	1	8	4	6	01/01/04	Israeli et al.			05/21/03	
	55	1	0	6	1	4	6	2	5		Israeli et al.					07/02/03		
	56	Preliminary Amendment re Exhibit 55								Israeli et al.					07/02/03			
	57	0	8	8	9	4	5	8	3		Israeli et al.					02/13/98		
EXAMINER										DATE CONSIDERED								
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